IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:	)	
	)	
Dan Kikinis	)	Examiner: Saltarelli, Dominic D.
	)	
Application No. 09/875,547	)	Art Unit: 2421
	)	
Filed: June 5, 2001	)	Confirmation No.: 6896
	)	
For: ENHANCED HOME ENTERTAINMENT SYSTEM WITH REMOVABLE LONG-TERM STORAGE	)	Attorney Docket Number: 007287.00008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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U.S. Patent and Trademark Office
Customer Service Window
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401 Dulany Street
Alexandria, VA 22314

Sir:

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the Final Office Action dated April 9, 2010 ("Final Office Action"), Applicant respectfully submits that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific errors relied upon in this Pre-Appeal Brief Request for Review include the following:

- The Office erred in its rejection of claims 1, 4-8, 11-15 and 18-24 under 35 U.S.C. §103(a) as being unpatentable over Hassell *et al.* (US 2004/0128685 A1, "Hassell") in view of Shintani (5,668,591, "Shintani") and Lee *et al.* (5,937,163, "Lee"). For example, claims 1, 8 and 15 all relate to, *inter alia*, "receiving, by a content rendering system, a command to record a program; determining whether a second storage device is available, wherein the second storage device is separate from the content rendering system; [and] in response to determining that the second storage device is unavailable, automatically recording the program to a first storage device."
- In response to Applicant's remarks and amendments of January 25, 2010, the Office concedes that Hassell lacks an explicit disclosure that unambiguously teaches the claimed limitations, but reasserts that "it remains the examiner's understanding of Hassell that upon actual implementation of the disclosed system, the claimed features of determining whether a second storage device, separate from the content rendering system is available upon received [sic] a record command, and defaulting to a first storage device is [sic] the second is determined to be unavailable." *See* final Office Action at p. 2. However, Applicant respectfully notes that such an understanding or interpretation is not supported by the actual teachings of Hassell.
- As noted in Applicant's response dated January 25, 2010, the Office asserts that digital storage device 31 constitutes the first storage device of claim 1 and secondary storage device 32 is the second storage device recited in claim 1. See, e.g., Final Office Action at p. 3. Even assuming, without conceding, that such an analogy is valid, there is no teaching or suggestion of checking secondary storage device 32 for availability to record a program before automatically recording to a first storage device, as recited in the claims. The Final Office Action asserts at p. 3 that Hassell's description of automatically checking the storage capabilities of the currently loaded digital storage medium corresponds to a description that the removable storage is checked first and that such a description indicates a clear preference for utilizing external removable media for

recording programs. Applicant respectfully disagrees as the Final Office Action's interpretations and assertions are not supported by the cited passage or any other passage of Hassell. The mere fact that Hassell will check an available storage capacity of a digital storage medium to make sure there is sufficient space does not describe checking a removable storage first. *See*, *e.g.*, para. [0043], [0047], [0051]. Indeed, read in context with preceding para. [0042], Hassell's reference to digital storage medium in para. [0043] relates to digital storage device 49, not secondary storage device 47.

- Furthermore, the Final Office Action's reliance upon the order in which Hassell's description of output to a secondary storage and Hassell's description of output to a digital storage device is misplaced. In particular, Hassell does not teach or suggest that the order in which the descriptions appear in the application implies or even suggests the required or preferred order in which storage is performed. In fact, Hassell describes operation with respect to the secondary storage as ***optional***. See, e.g., para. [0019], ll. 12-14.
- Moreover, even assuming, without conceding, that Hassell describes checking a capability of the secondary storage device first, Hassell still lacks a description of what happens when the removable digital storage medium does not have sufficient capacity. In response to Applicant's arguments, the Final Office Action asserts that Hassell's automated best fit algorithm is used to ensure the program is recorded if at all possible and that there is an explicit disclosure of searching for available storage space that is not limited to a single, loaded volume since the system "does not simply freeze up if it is determined that a preferred external DVD drive happens to not have a disc loaded into it." p. 4. With respect to the Final Office Action's citation of Hassell's best fit algorithm, Applicant respectfully notes that the best fit algorithm merely refers to how to store data on a single storage device, not that data may be stored on a second storage device if a first storage device does not have sufficient capacity. Hassell at para. [0051]. For example, and as noted by the Final Office Action at p. 4, Hassell describes the best fit algorithm using non-contiguous space on a storage medium. *Id.*
- The Final Office Action's further assertion that the claimed feature of automatically recording the program to a first storage device in response to determining that the second

storage device is unavailable is disclosed by Hassell because the system would not simply freeze up if it is determined that a preferred external DVD drive happens to not have a disc loaded into it appears to rely on inherency. However, the fact that a certain result or characteristic may occur or be present in the prior art is **NOT** sufficient to establish the inherency of that result or characteristic. MPEP § 2112(IV) (citing *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (emphasis added). To establish inherency, "the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Here, the Office Action has neither shown nor proven that the functionality of storing the content on a second storage device when a first device does not have sufficient capacity is ***necessarily present*** in Hassell or any of the other cited documents. Indeed, instead of freezing up or automatically recording the content to a second storage system, the system may prompt the user to insert a disc. Accordingly, Applicant submits that the recited feature of automatically recording the program to a first storage device in response to determining that the second storage device is unavailable is not inherently described by Hassell.

- None of the cited secondary documents cure these deficiencies of Hassell.
- In view of the foregoing, Applicant respectfully submits that claims 1, 4-7, 11-15 and 18-24 are allowable over the pending rejections.

While Applicant believes the above points represent the clearest errors made by the Office, Applicant reserves the right to appeal on other bases and errors. In addition, Applicant believes the rejections of other claims not identified above are also based on one or more Office errors. Applicant will address such issues on appeal should the appeal of this case proceed after the Office's consideration of this paper.

CONCLUSION

All issues having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3156.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 9th Day of July, 2010

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